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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/667,872	09/22/2003	Takchiko Nakano	09812.0377-00000	1172
22852 7590 04/10/2007 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER SHAN, APRIL YING	
			ART UNIT 2135	PAPER NUMBER
SHORTENED STATUTORY PERIOD OF RESPONSE 3 MONTHS		MAIL DATE 04/10/2007	DELIVERY MODE PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/667,872

Applicant(s)

NAKANO, TAKEHIKO

Examiner

April Y. Shan

Art Unit

2135

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 January 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-15 and 17-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-15 and 17-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The Applicant's amendment, filed 11 January 2007, has been received, entered into the record, respectfully and fully considered.
2. As a result of the amendment, claims 1-4, 6-15 and 17-23 have been amended. Claims 5 and 16 are canceled. Claims 1-4, 6-15 and 17-23 are now presented for examination.
3. Any objections or rejections not repeated below for record are withdrawn due to Applicant's amendment/explanation/cancellation.

Claim Objections

4. Claims 10, 21-23 are objected to because of the following informalities:

As per **claims 10 and 21**, the whole claims are incomprehensible.

As per **claim 22**, the claim is depended on the cancelled claim 16.

As per **claim 23**, "an information processor" is recited. However, it is not clearly defined/supported in the original disclosure. Applicant is required to point out where this amended claim limitation is in the original disclosure and please note **no new matter should be added** in the original disclosure in addressing this claim objection.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 7, 10, 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

As per **claims 7 and 18**, "the limitation is a minimum amount of time that must expire between replacing..." is being recited. However, on page 8 of the original disclosure, the Applicant discloses "For example,... further changing of registration information is inhibited until **a predetermined** period of time elapses". It appears to the examiner, a predetermined period of time disclosed in the original disclosure is a **fixed** value and does not have a minimum and maximum value. Therefore, "a minimum amount time" recited in the claim is a new matter and does not supported by the original disclosure.

In order to further examine on the merits of claims 7 and 18 and in light of the Applicant's specification, the examiner interprets "a minimum amount time" as "a predetermined period of time".

As per **claims 10 and 21**, "charges fees for changing the maximum number of times identification information can be replaced" is being recited. However, on page 9 of the original disclosure, the Applicant discloses, "...charging depending on the maximum allowable number of times already registered identification information is changed". It appears to the examiner, charging depending on the maximum allowable number of times already registered identification information is changed means charges

depends on the changed maximum allowable number of times, not for charge fees for changing the maximum number of times identification information can be replaced. Therefore, "charges fees for changing the maximum number of times identification information can be replaced" recited in the claim is a new matter and does not supported by the original disclosure.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 23 is directed to a computer program described in a computer readable format for causing a computer system to execute a process of controlling use of a content under a predetermined condition. The examiner respectfully asserts that the claimed subject matter does not fall within the statutory classes listed in 35 USC 101. The claimed computer program does not result in a tangible result. Claim 23 is rejected as being directed to a software does not result in a tangible result (i.e., producing non-tangible result) [tangible requirement does require that the claim must recite more than a 101 judicial exception, in that the process must set forth a practical application of that 101 judicial exception to produce a real-world result, Benson, 409 U.S. at 71-72, 175 USPQ at 676-77).

Claim Rejections - 35 USC § 103

8. Claims 1-4, 6-15 and 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansell et al. (U.S. Patent 6,792,113) and in view of Yamada et al. (U.S. Patent 6,954,830).

As per **claims 1, 7, 12 and 18**, Ansell et al. discloses a content usage control apparatus/method for controlling use of a content under a predetermined condition, comprising:

acquiring first identification information for a first client, the first client being an apparatus or user requesting use of the content ("authentication server sends an information template for new machine bound passports. An information template is a collection of data specifying user-supplied data fields and prompts therefore. The information template is an XML description of the data to collect from the user...Such information can be entered by the user using conventional user-interface techniques. Processing transfers to step 810" – e.g. col. 16, lines 37-50);

registering the first identification information acquired from the first client ("In step 810, content player 142 sends hardware identifier 140 and any user-supplied information to authentication server 126 as a request for a new machine-bound passport... Logic flow diagram 900 (fig. 9) illustrates processing by authentication server 126 (fig. 1) in response to a request for a new machine-bound passport made by content player 142 in step 810 (fig. 8)...authentication

server 126 associates the new certificate with the received hardware identifier, within certificate database..." – e.g. col. 16, lines 53-67 – col. 17, lines 1-23);

changing the registered first identification information and preventing further changes to the registered first identification information in accordance with a limitation (e.g. col. 17, lines 27- 58);

in response to the request for use of the content issued by the first client, determining whether the use of the content is allowed on the basis of whether the first identification information is currently registered ("content player determines whether the entered password corresponds to the full passport. If the password corresponds to the selected full passport, processing transfers to step 708 in which processing of the purchase for content continues" – e.g. col. 15, lines 13-16 and col. 15, lines 23-28; "content player determines whether hardware identifier is the hardware identifier corresponding to the machine-bound passport located by content player. If hardware identifier is the correct identifier, processing transfers from test step 714 to step 708 and the purchase process continues and any purchased content is bound to a machine-bound passport" – e.g. col. 15, lines 56-59, col. 16, lines 9-13, col. 18, lines 9-24, fig. 7 and fig. 10).

Ansell et al. does not expressly disclose modifying the limitation and the limitation can be a predetermined period of time.

However, Yamada et al. discloses modifying the limitation and the limitation can be a predetermined period of time (e.g. col. 4, lines 54-60)

It would have been obvious to a person with ordinary skill in the art to combine Yamada et al.'s modifying the limitation into Ansell et al.'s method/apparatus.

The motivation of doing so would have been to provide convenience to purchasers of digital data since purchasers of digital data have a relatively low tolerance for inconvenience, in particular, when a user loses a machine-bound passport through inadvertent deletion or through data loss due to a hardware failure, as suggested by Ansell et al. (col. 2, lines 17-19 and col. 17, lines 29-32)

As per **claims 2 and 13**, Ansell et al. – Yamada et al. disclose a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses registration is performed in response to a request issued by the first client (e.g. logic flow diagram 718 in fig. 8 and logic flow diagram 900 in fig. 9).

As per **claims 3 and 14**, Ansell et al. – Yamada et al. disclose a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses new registration is performed only when a current number of registrations is smaller than a predetermined maximum allowable number of registrations ("logic flow diagram by authentication server in response to a

request for a new passport which includes full passport information... Typically, full passports are permitted to hold only a limited number of additional keys such that users cannot collect machine-bound keys and content from friends and colleagues without limitation. Passport key limit 1912 specifies a maximum number of keys held by a passport based upon key record. Authentication server compares the number of keys already held in the full passport of the user to the limit specified in passport key limit to determine whether the passport can include more keys” – e.g. col. 22, lines 3-48 and step 912 in fig. 9).

As per **claims 4 and 15**, Ansell et al. – Yamada et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses an invalidation flag (Ansell et al.’s key pair associated with hardware identifier 140 (fig. 1) corresponds to the Applicant’s invalidation flag) for controlling provision of a service to the first client is stored together with the first identification information of another apparatus or user (e.g. col. 17, lines 24-26 and step 904 in fig. 9); and the use of the content by the first client is limited, if the invalidation flag associated with the first client is set (col. 17, lines 26-44).

As per **claims 6 and 17**, Ansell et al. – Yamada et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses wherein the limitation is a maximum number of times identification information can be replaced (e.g. col. 17, lines 24 - 58).

As per **claims 8 and 19**, Ansell et al. – Yamada et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses wherein when the registered first identification information for the first client is replaced with second identification information for a second client, the second client is requested to perform a particular operation (“In addition, since the user-bound passport is not bound to any particular hardware identifier, the content and the user-bound passport can be moved from computer system to computer system and can be played back with only the effort required to enter the user's password and to view the user's private information” – e.g. col. 3, lines 40-46).

As per **claims 9 and 20**, Ansell et al. – Yamada et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses wherein when the registered first identification information is replaced with second identification for a second client, submission of change permission information is requested from the second client or manager (“Logic flow diagram 900 (fig. 9) illustrates processing by authentication server in response to a request for a new machine-bound passport made by content player in step 810 (fig. 8) “– e.g. col. 16, lines 58-61).

As per **claims 10 and 21**, Ansell et al. – Yamada et al. discloses a content usage control apparatus/method as applied in claims 6 and 17. Ansell et al. further discloses charging fees for changing the maximum number of times identification information can be replaced (e.g. col. 3, lines 3-9, col. 17, lines 39-58, col. 10, lines 60-63, col. 21, lines 9-19).

As per **claims 11 and 22**, Ansell et al. – Yamada et al. discloses a content usage control apparatus/method as applied in claims 1 and 12. Ansell et al. further discloses when the limitation is modified, submission of change permission information is requested from a different apparatus or a manager (“Logic flow diagram 900 (fig. 9) illustrates processing by authentication server in response to a request for a new machine-bound passport made by content player in step 810 (fig. 8) “– e.g. col. 16, lines 58-61).

As per **claim 23**, Ansell et al. – Yamada et al. discloses the claimed method of steps as applied above in claim 1. Therefore, Ansell et al. – Yamada et al. discloses the claimed for computer program described in a computer-readable format carrying out the method of steps.

Response to Arguments

9. Applicant's arguments filed 11 January 2007 have been respectfully and fully considered but they are not persuasive.

10. On page 17 of the Applicant's remark, the Applicant states "By this Amendment, Applicant amends claims...5-15..." is an error. The fact is that the Applicant cancels claim 5.

11. Regarding Applicant's argument on rejection claim 23 under 35 U.S.C. § 101, the examiner maintains the rejection because the examiner does not find any support in the original specification on newly added claim limitation "an information processor".
(Please see above claim objection to claim 23).

12. Regarding Applicant's argument on "Ansell does not disclose modifying the limitation...and Ansell fails to disclose a minimum amount time that must expire before the keys can be replaced..." on pages 20-21.

The examiner respectfully addressed the above argument in the above 112 and 103 rejection.

Conclusion

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13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (See PTO – 892)

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


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Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to April Y. Shan whose telephone number is (571) 270-1014. The examiner can normally be reached on Monday - Friday, 8:00 a.m. - 5:00 p.m., EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Y. Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


30 March 2007
AYS


HOSUK SONG
PRIMARY EXAMINER